

### **REMARKS**

This responds to the Office Action mailed on May 8, 2007.

Claims 1, 15, 16, 20, and 25 are amended; as a result, claims 1-2, 4-5, 7-16, and 18-27 are now pending in this application.

#### **§102 Rejection of the Claims**

Claims 1, 2, 4, 5, 7-12, 13-15, 16, 18, 19, 20-24 and 25-27 were rejected under 35 USC § 102(e) as being anticipated by Kinnunen et al. (U.S. 6,813,501).

The Applicant does not admit that Kinnunen is prior art and reserves the right to swear behind this reference at a later date. In addition, because Kinnunen does not disclose the identical invention claimed, the Applicant respectfully traverses this rejection.

#### **Claim 1**

Amended independent claim 1 as currently presented recites in part “a service broadcaster capable of being communicatively coupled to the mobile element and broadcasting a second service preference to the mobile element based on the position of the mobile element, the service broadcaster including a first comparator module configured to filter the second service preference based on preferences received from the mobile element.”

The Office Action states that Kinnunen discloses the above elements of claim 1. In contrast, Kinnunen apparently merely discloses, “The LDSs 242 include location aware services 246 and location critical services 248 (col. 10, lines 8-9).” Kinnunen does not teach “a service broadcaster capable of being communicatively coupled to the mobile element and **broadcasting a second service preference to the mobile element based on the position of the mobile element**, the service broadcaster **including a first comparator module configured to filter the second service preference based on preferences received from the mobile element**.”

Additionally, amended independent 1 as currently presented recites in part, “a second comparator module included in the mobile element to compare the first and second service preferences, wherein an application is downloaded to the memory when the first and second service preferences are determined to be related by the comparator module.” In contrast,

Kinnunen apparently merely discloses, “a profiling sub-system which keeps and/or compiles profiles related to one or more of a user, mobile terminal and a service (col. 3, lines 28-30).” Kinnunen does not teach, **“a second comparator module included in the mobile element to compare the first and second service preferences, wherein an application is downloaded to the memory when the first and second service preferences are determined to be related by the comparator module.”**

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). In fact, “[t]he *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Further, if the Office relies on inherency in alleging that “comparison is implicit in the processor in order to select required profile information corresponding to selected profile” then, as recited in MPEP § 2112, “... the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such basis has been provided.

Therefore, since Kinnunen does not teach all of the elements of claim 1, as described above, what is disclosed by Kinnunen is not identical to the subject matter of the embodiments claimed, and the rejection of claim 1 under § 102(e) is improper. Reconsideration and allowance are respectfully requested.

Claims 2, 4-5, and 7-12 further define patentably distinct independent claim 1. Accordingly, dependent claim 2, 4-5, and 7-12 are believed to be allowable over the cited reference. Allowance of 2, 4-5, and 7-12 is respectfully requested.

#### Claim 13

Independent claim 1 as currently presented recites in part “a comparator module communicatively coupled to the memory to compare the first and second service preferences.” As described above under claim 1, Kinnunen does not teach the above element of claim 13. Reconsideration and allowance are respectfully requested.

Claims 14 and 15 further define patentably distinct independent claim 13. Accordingly, dependent claims 14 and 15 are believed to be allowable over the cited reference. Allowance of claims 14 and 15 is respectfully requested.

#### Claim 16

Amended independent claim 16 as currently presented recites in part, “a memory coupled to the processor and configured to receive a position of a mobile element and a first service preference associated with the mobile element, the memory including a second service preference associated with the position; and a comparator module included in the apparatus to compare the first and second service preferences.” As described above under claim 1, Kinnunen does not teach the above element of claim 16. In particular, Kinnunen does not teach, **“the memory including a second service preference associated with the position; and a comparator module included in the apparatus to compare the first and second service preferences.”** Reconsideration and allowance are respectfully requested.

Claims 18 and 19 further define patentably distinct independent claim 16. Accordingly, dependent claims 18 and 19 are believed to be allowable over the cited reference. Allowance of claims 18 and 19 is respectfully requested.

#### Claim 20

Amended independent claim 16 as currently presented recites in part, “wherein the application is downloaded from a service broadcaster to the mobile element upon the mobile

element determining using a comparator that the first service preference is related to a second service preference.” As described above under claim 1, Kinnunen does not teach the above element of claim 20. In particular, Kinnunen does not teach, “wherein the application is **downloaded from a service broadcaster to the mobile element upon the mobile element determining using a comparator** that the first service preference is related to a second service preference.” Reconsideration and allowance are respectfully requested.

Claims 21-24 further define patentably distinct independent claim 20. Accordingly, dependent claims 21-24 are believed to be allowable over the cited reference. Allowance of claims 21-24 is respectfully requested.

#### Claim 25

Amended independent claim 25 as currently presented, includes similar elements presented under claim 20. For the same reasons as presented under claim 20, Kinnunen does not teach all elements of claim 25. Reconsideration and allowance are respectfully requested.

Claims 26-27 further define patentably distinct independent claim 25. Allowance of claims 26-27 is respectfully requested.

### **RESERVATION OF RIGHTS**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant’s silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or

affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### **CONCLUSION**

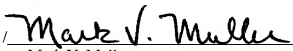
Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((210) 308-5677) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MATTHEW A. HAYDUK

By his Representatives,  
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, Minnesota 55402  
(210) 308-5677

By /  /  
Mark V. Muller  
Reg. No. 37,509